

### **REMARKS/ARGUMENTS**

The Office Action mailed February 23, 2005 has been reviewed and carefully considered. Claims 8 and 12 have been amended. Claims 17-18 are added. Claims 8-18 are pending in this application, with claim 8 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

The disclosure was objected to because of minor informalities. The Examiner states that on page 5, line 21, of the original specification, the reference numeral "3" is incorrect. This portion of the original specification was corrected in an amendment filed on June 21, 2004. The Examiner further states that the text on page 6, lines 13-15 is unclear because it indicates that sleeve 13 is screwed onto sleeve 12 while Fig. 3 shows that the sleeves 12 and 13 are one unitary piece. The specification has now been amended to clarify that the sleeves 12 and 13 may alternatively comprise one unitary piece as shown in Fig. 3. In view of the above amendments and remarks, the objection to the specification should now be withdrawn.

Claims 8-16 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner does not see how covering 7 can have a circumferential shape which corresponds to the circumferential shape of the trough. This rejection was discussed by the Examiner and A. Froebrich by telephone on March 25, 2005. As discussed, the circumferential shape referred to in the specification is the face of the covering section of the covering 7, wherein the covering section is the portion of the covering 7 that covers the trough 5. Furthermore, The circumferential shape of the covering section corresponds to the circumferential shape of the perimeter of the spoon-shaped trough 5 (see page 5, lines 9-12 of the original specification). Therefore, the circumferential shape relates to the top view of the trough 5, i.e., the

shape defined by the edge or rim of the spoon-shaped trough. The view shown by Fig. 3 is a cross sectional side view of the endoscopic sample taker.

It is respectfully submitted that those skilled in the art of endoscopic sample takers are enabled by the specification to make and use the claimed endoscopic sample taker. The claims do not specifically recite the circumferential shape of the of the covering. Rather, the claims now recite that "said trough comprises an edge defining a shape of said opening of said trough, said covering sufficiently covering said trough in said closed position so that an entire sample within the volume defined between said opening and said closed end is prevented from leaving said trough". The specification states that the covering 7 is tongue-shaped and is preferably made of thin metal (see page 5, lines 6-9). The specification also states that the covering 7 sufficiently covers the trough 5 so that gained cartilage material is not lost during retraction of the sample taker (see page 5, lines 12-15). From this disclosure, it is respectfully submitted that those skilled in the art could make a thin strip covering 7 that covers the circumference of the spoon-shaped trough when the covering is in the closed position.

In view of the above amendments and remarks, it is respectfully submitted that the rejection of claim 8-16 under 35 U.S.C. §112, first paragraph, should now be withdrawn.

Claims 8-16 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,318,528 (Heaven) in view of U.S. Patent No. 4,569,131 (Falk).

Independent claim 8 is amended to recite "a position of said covering being adjustable via said actuating rod to an adjusted position between a closure position and an open position" and "said adjusted position being maintained without external force on said actuating rod". Support for this amendment is found in the original specification at page 7, lines 1-5. This section discloses that the outer ring 17 must be actuated for both closing and opening the trough.

Therefore, the covering 7 remains in the last position it was moved to. The combined teachings of Heaven and Falk fail to disclose this limitation.

Heaven discloses an anthroposcopic grasper in which a wire 6 is tensioned to open the jaws 5. Since a wire is only tensioned (pulled) and can not easily be compressed (pushed), Falk discloses that jaws are normally in the closed position and are actuated to open. Accordingly, Heaven fails to disclose that the jaw can be adjusted to any position between the open and closed position and held in that position without external forces on the actuating rod. Rather, Heaven discloses that only the closed position is maintained when no force is applied to the wire 6 and that tension must be held on the wire 6 to keep the jaws open.

Falk likewise discloses a spring 2 for urging the grips to a first position (see col. 3, lines 29-32). Therefore Falk fails to teach or suggest that the jaw can be adjusted to any position between the open and closed position and held in that position without external forces on the actuating rod.

In view of the above amendments and remarks, independent claim 8 is deemed to be allowable over Heaven in view of Falk.

Dependent claims 9-18, each being dependent on independent claim 8, are deemed to be allowable for at least the same reasons as independent claim 8, as well as for the further recitations therein.

Dependent claim 12 is amended to recite that a retrograde inclination, i.e., rearward facing inclination, is exhibited by the edge of the scoop. Neither Heaven nor Falk discloses this limitation. Fig. 6 of Falk discloses that the actuation rod is bent to produce a forward facing inclination. Accordingly, dependent claim 12 is allowable for these additional recitations.

New dependent claim 17 is added and recites "said covering comprises a thin strip having a longitudinal length, wherein the position of the covering is adjustable by axially displacing the thin strip across the opening defined by said spoon-shaped trough in response to said actuating rod". Support for these limitations is found in the specification at page 5, lines 19-22 and lines 27-29. Both Heaven and Falk disclose covers that are pivotally connected. Accordingly, Heaven and Falk fail to disclose, teach or suggest a cover that is axially displaceable, as expressly recited in dependent claim 17. Accordingly, dependent claim 17 should be allowable over Heaven in view of Falk.

New dependent claim 18 corresponds to claim 11 but is dependent on dependent claim 17. Neither Heaven nor Falk disclose teach or suggest "holding-down device for guiding said thin strip during the displacement thereof and holding said thin strip at said closure position", as expressly recited in dependent claim 18

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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